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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LIPMAN, BERNARD

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 03/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,981

Applicant(s)

GOTTSCHALL, KLAUS

Examiner

Bernard Lipman

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6 and 9-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

Art Unit 1713

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-6, 9 and 11-13, drawn to methods of treating polymers, the polymer derivatives produced therefrom and the process of bonding using said polymers, classified in Class 525, subclass 326.1+.

II. Claims 10, 14 and 15, drawn to compounds, classified in Class 548, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

The derivatives, process and products of Group I and the compounds of Group II represent two distinct inventions with different special technical features not present in the other group in each case. The method of treating the polymers as well as the polymers produced therefrom and the process of using said polymers nowhere relies on specific compound structures which are only representative of a few of even the narrow genus of compounds used in the process. The special technical feature, therefore, of the process and derivative polymers cannot reside in the compounds themselves since the process and derivative polymers are not restricted to said compounds. Having separate special technical features determines that there is lack of unity between the two groups of claims and restriction is, therefore, proper.

Art Unit 1713

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2. Claims 1-6, 9 and 11-13 are rejected under 35 U.S.C. § 112, both first and second paragraphs, in being broader than one of ordinary skill in the art is enabled, from the disclosure, to practice the invention and as being indefinite as to scope. The disclosure gives one of ordinary skill in the art certain information with regard to reacting specific polymers or groups of polymers with specific functionalizing agents in a variety of different reaction orders. The polymers are of specific structure and the reactants are also of specific structure. This is necessarily true insofar as one of ordinary skill in the art needs information with regard to parameters and conditions of reaction in order to effectively produce useful products from any given reaction. The claims are to such a broad scope of potential polymers, the functional groups on said polymers not even, for the most part, identified, and an unlimited number of both reactive and "derivatized" reactants. The reagents are classified as "activating" or "derivatizing" reagents. The actual difference between these two is also not clear. The multitude of possible meanings for these terms, let alone the number of potential combinations of polymers and reagents, renders the claims both indefinite as to scope and far broader

Serial No. 09/856,981

-4-

Art Unit 1713

than one of ordinary skill in the art is enabled from the disclosure to practice the invention. Claims are, therefore, properly rejected under 35 U.S.C. § 112, both first and second paragraphs.

Rejection under 35 U.S.C. § 112 has been made in this application in order to expedite prosecution. Consideration of the prior art is held in abeyance pending resolution of the requirement for restriction herein.



BERNARD LIPMAN  
EXAMINER  
ART UNIT 1551713

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March 6, 2002